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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,564	01/08/2007	Thierry Cholley	Q93036	6629

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EXAMINER

BOYER, RANDY

ART UNIT	PAPER NUMBER
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1797

NOTIFICATION DATE	DELIVERY MODE
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03/05/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/567,564	Applicant(s) CHOLLEY ET AL.	
	Examiner RANDY BOYER	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6 October 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of claims 1-22 in the reply filed on 30 November 2009 is acknowledged.
2. Claim 23 is withdrawn from further consideration by the examiner as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 5-8, 19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Taira (US 3,544,485).

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5. With respect to claims 1 and 5-8, Taira discloses a catalyst comprising a base of at least one refractory oxide (alumina) (see Taira, column 1, lines 12-16; and column 2, lines 47-53), at least one metal of group VIII (cobalt) (see Taira, column 2, lines 28-31) and at least one metal of group VIB (molybdenum) (see Taira, column 2, lines 38-41), further comprising an oxime (benzophenone oxime) (see Taira, column 3, lines 71-75; and column 4, lines 37-38).

6. With respect to claims 19 and 22, Taira discloses wherein his catalyst is prepared by contacting at least one refractory oxide with catalyst metals and with an organic compound in a hydrocarbon charge to be hydrogenated (see Taira, column 6, lines 65-72).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
10. Claims 10-13, 17, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taira (US 3,544,485).
11. With respect to claims 10-13, see discussion *supra* at paragraph 5.

Taira does not explicitly disclose wherein the oxime is one as specified in Applicant's 10-13.

However, Taira is not specifically limited with respect to the exact oxime to be used in his catalyst. Rather, Taira discloses that any suitable oxime (aldoxime or ketoxime) may be used (see Taira, column 3, lines 71-72).

Thus, Examiner finds Applicant's claims 10-13 unpatentable over the disclosure of Taira.
12. With respect to claims 17 and 18, Taira discloses use of the oxime in an amount of 1/20 the weight of the catalyst metals (see Taira, column 4, lines 37-40).

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13. With respect to claim 21, see discussion *supra* at paragraph 6. Taira is not specifically limited with respect to the source of oxime used, whether it be produced *in situ* or *ex situ*. Rather, Taira discloses that any suitable oxime (aldoxime or ketoxime) may be used (see Taira, column 3, lines 71-72).

Thus, Examiner finds Applicant's claim 21 unpatentable over the disclosure of Taira.

14. Claims 2-4, 9, 14-16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taira (US 3,544,485) in view of Maskill (Howard Maskill, *Mechanisms of Organic Reactions*, New York, Oxford University Press Inc., 1996, p.62).

15. With respect to claims 2-4 and 20, see discussion *supra* at paragraphs 5 and 6.

Taira does not explicitly disclose wherein the oxime is formed by the reaction of an amine and a carbonyl compound.

However, oximes are known reaction products of amines and carbonyl compounds – e.g., the reaction of hydroxylamine and a ketone is known to produce oximes (see Maskill, page 62).

Thus, Examiner finds Applicant's claims 2-4 and 20 unpatentable over Taira over what is already common knowledge in the art (as evidenced by Maskill).

16. With respect to claims 9 and 14, the formation of an oxime is known to proceed through with a second group having a free pair of electrons (e.g., a hydroxyl group) (see Maskill, page 62).

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17. With respect to claims 15 and 16, Taira is not specifically limited with respect to the exact oxime to be used in his catalyst. Rather, Taira discloses that any suitable oxime (aldoxime or ketoxime) may be used (see Taira, column 3, lines 71-72).

Thus, Examiner finds Applicant's claims 15 and 16 unpatentable over the disclosure of Taira.

Conclusion

18. The prior art made of record and not expressly relied upon is considered pertinent to Applicant's disclosure: Meyer (US 3,978,001) and Mansfield (US 5,648,305).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Boyer whose telephone number is (571) 272-7113. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:00 P.M. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola, can be reached at (571) 272-1444. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randy Boyer/

Examiner, Art Unit 1797

/Glenn A Caldarola/

Supervisory Patent Examiner, Art Unit 1797